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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,345	04/07/2004	Ping-Lin Kuo	08688.0339US01	8124
23552	7590	12/08/2006	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			HAILEY, PATRICIA L	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 12/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/820,345

Applicant(s)

KUO ET AL.

Examiner

Patricia L. Hailey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicants' remarks and amendments, filed on September 26, 2006, have been carefully considered. No claims have been canceled or added; claims 1-13 remain pending in this application.

Maintained Rejections

The following rejections of record have been maintained; the text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

1. Claims 1-13 stand rejected under 35 U.S.C. 102(b) as being anticipated by Yamauchi et al. (U. S. Patent No. 3,988,288).

Yamauchi et al. disclose a powder paint composition comprising an epoxy compound and an amino polyester resin as essential components, but may also contain other resins or other compounds, such as pigments and additives. See the Abstract of Yamauchi et al., as well as col. 2, lines 60-65 and col. 6, lines 42-45..

The type of epoxy compound "is not limited from any point" (col. 4, lines 13-16); examples thereof include any polyepoxide compounds containing two or more epoxy groups, such as diglycidyl esters and epoxy-group containing acrylic resins. See col. 6, lines 21-41 of Yamauchi et al. Because this reference discloses an epoxy compound recited in the instant claims (e.g., claim 3), the claim limitations regarding the "epoxy equivalent weight" are considered inherently encompassed by Yamauchi et al.

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The powder paint composition can be prepared by mixing the amino polyester resin with the epoxy compound, and preferably with other resins or other compounds, coloring pigments, extender pigments, etc., and blending the mixture in conventional methods. See col. 3, lines 23-27 of Yamauchi et al., as well as col. 7, lines 37-51, which discloses exemplary blending conditions, i.e., under melt at an elevated temperature of 80°C to 130°C, and also discloses the feasibility in including additives such as wetting agents, leveling agents, flow control agents, antifoam agents, etc. (considered to read upon the limitations "dispersing agent" and "solvent" in claims 5 and 9, respectively).

In view of these teachings, Yamauchi et al. anticipate claims 1-13.

2. *Claims 1-13 stand rejected under 35 U.S.C. 102(b) as being anticipated by Ohnishi (U. S. Patent No. 5,747,599).*

Ohnishi discloses coating compositions comprising (a) an epoxy compound, (b) an aromatic sulfonium salt, and (c) an acidic pigment or (d) a neutral or basic pigment, and (e) and acidic substance. See col. 1, lines 58-65 of Ohnishi.

Examples of the epoxy compound include polyalkylene ether type compounds such as (poly) ethylene glycol diglycidyl ether, glycidyl ester type epoxy compounds, alicyclic epoxy compounds, homopolymers of unsaturated epoxy-containing monomers such as glycidyl (meth)acrylate, etc. See col. 2, line 27 to col. 3, line 15 of Ohnishi, which also discloses that the epoxy equivalent of the epoxy compound is not critical, but is suitably in the range of about 65 to about 50,000, preferably about 180 to about 5000.

The coating compositions may also contain organic solvents, as well as agents such as pigment dispersants. See, for example, col. 6, lines 16-41 of Ohnishi.

The compositions can be prepared in "the conventional manner", such as by mixing. See: (1) col. 6, lines 8-15 of Ohnishi, as well as col. 8, lines 1-12, in which the epoxy compound is dissolved or dispersed in an organic solvent, which is admixed with the sulfonium salt and a pigment paste, (2) col. 8, line 48 to col. 9, line 30-60, in which, in one embodiment, toluene (solvent), glycidyl methacrylate, styrene, methyl methacrylate, and n-butyl acrylate are admixed, and heated to undergo reaction to obtain an epoxy resin, and (3) Example 20, in which the epoxy resin is admixed with titanium dioxide.

In view of these teachings, Ohnishi anticipates claims 1-13.

Response to Arguments

With respect to Applicants' argument that Yamauchi et al. "do not use a volatile dispersing medium", it is the Examiner's position that Applicants' claims in their present form do not recite a "volatile dispersing medium." Applicants' "dispersing medium" is not defined or exemplified; water could be considered to read upon the claim limitation "dispersing medium".

Although Yamauchi et al. teach a chemical reaction between the resin and the epoxy compound, the reference teaches admixture of the amino polyester resin, the epoxy compound, and of pigments (col. 3, lines 23-27), which is considered to read upon Applicants' "reacting" and "mixing" (e.g., "mixing the pigment particles" in claim 9).

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With respect to Applicants' arguments that Ohnishi teaches the presence of an aromatic sulfonium salt as "a catalyst for ring opening cationic polymerization of the epoxy compound to form a coating film", it is the Examiner's position that Applicants' claims in their present form do not exclude said sulfonium salt. Therefore, the presence of the sulfonium salt is not seen to detract Ohnishi from reading upon Applicants' claims in their present form.

Because both references teach admixture of pigments with an epoxy compound, as set forth in the maintained rejections of record, the limitation "to provide a surface treatment of the particles" is considered encompassed both by Yamauchi et al. and Ohnishi.

For these reasons, Applicants' arguments are not persuasive, and the rejections of record are maintained.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

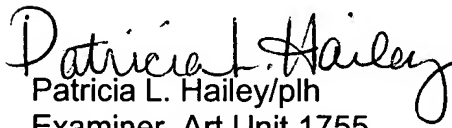
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (571) 272-1369. The examiner can normally be reached on Mondays-Fridays, from 7:00 a.m. to 3:30 p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1700 Receptionist, whose telephone number is (571) 272-1700.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Patricia L. Hailey/plh
Examiner, Art Unit 1755
December 4, 2006


J.A. LORENZO
SUPERVISORY PATENT EXAMINER